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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,105	07/08/2003	Isao Yamazaki	KAS-187	7653
24956 7590 11/13/2007 MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314			EXAMINER TURK, NEIL N	
			ART UNIT 1797	PAPER NUMBER
			MAIL DATE 11/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/614,105

Applicant(s)

YAMAZAKI ET AL.

Examiner

Neil Turk

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5 and 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/8/03 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Remarks

This Office Action fully acknowledges Applicant's remarks filed on August 29th, 2007. Claims 1, 3-5, and 7-9 are pending. Claims 2, 6, and 10-12 have been cancelled.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-5, and 7-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The recitation of, "a plurality of reagent disks that rotate independently of each other:" is unclear in that the specification states that the plural reagent disks may be arranged concentrically with their central axes extending along the same line and also states that the reagent disks can rotate independently with each other (pages 5 and 13). However, in the case that the reagent disks rotate independently with each other, the specification teaches that only one dispensing probe is utilized. The claims currently require plural dispensing probes (and further that at least one pair being arranged...). While being enabled for a single dispensing probe, the constitution of the reagent disks rotating independently with each other is not enabled in the case of a

plural amount of dispensing probes or a pair being arranged as claimed. Further, from the drawings and the specification it appears that embodiments the invention are being mixed for which support does not exist.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-5, and 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites, "...a plurality of reagent dispensing probes...wherein at least one pair of said reagent dispensing probes..." The recitation of a plurality of reagent dispensing probes followed by one pair of dispensing probes is unclear. A plurality of dispensing probes may include more than one pair and may be an odd amount of dispensing probes as well. Does Applicant wish to claim a plurality of pairs of dispensing probes? As currently recited, Examiner will take the language to read, "...wherein at least one of said reagent dispensing probes..."

Claim 7 recites the limitation "said plural reagent disks". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5, 8, and 9 are rejected under 35 U.S.C. 102(b) as anticipated by Ohishi et al. (6,019,945), hereafter Ohishi, or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ohishi.

Ohishi discloses a sample analysis system. Ohishi shows in figure 3 a controlled (connected to computer 6b and control unit 40) analysis unit 3B in which there are a plurality of reagent disks 26a, 26b that rotate independently of each other. Ohishi also

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shows a plurality of reagent dispensing probes 8a, 8b arranged to suck reagent from one of the reagent containers (12a, 12b), and inject the reagent into one of the reaction cells 46b (or reactor section 5b). Examiner further asserts that the reagent dispensing probes are arranged to inject reagent from the reagent container into the reaction cell arranged at the same position of the reaction disk such that the reagent dispensing probes may be swiveled (also vertically movable) to place reagent in the same reaction cell 46 at the same position (lines 23-67, col. 6; lines 1-13, col. 7, fig. 3). With regard to claim 4, Ohishi disclose several units (3A, 3C, 3D, 3E, 3F, and 3G) with such elements for performing single analyses.

If the reagent dispensing probes are not taken to be arranged to inject reagent sucked from the reagent container into the reaction cell arranged at the same dispensing position of the reaction disk, then it would have been obvious to modify Ohishi. It would have been obvious to modify Ohishi to the above functional arrangement so that both reagents could be added to the same reaction cell at the same position on the reaction disk so that the reaction disk would not have to move to different positions for the first and second reagents to be added. This configuration would be an obvious modification so as to avoid unwanted mixing and reacting of the contents in the reaction cell 46b that could occur in the movement of the reaction disk to a second position for further reagent.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohishi in view of Ohishi in view of Minekane (4,808,380).

Ohishi does not disclose at least one reagent disk arranged inside a reaction disk.

Minekane discloses an automatic chemical analyzing apparatus. Minekane discloses a cuvette rotor 18 in which cuvettes are mounted in an annular array to receive sample and reagent to be then analyzed by a photometer (reaction disk with reaction cells). Minekane further discloses reagent supply 14, which has a pair of coaxial reagent rings 24 and 26, and is placed peripherally within the ring of cuvette arrays (arranged inside the reaction disk) (lines 19-67, col. 2, fig. 1).

It would have been obvious to modify Ohishi to arrange reagent disks inside the reaction disk such as taught by Minekane in order to save space and optimize the workspace area.

Response to Arguments

Applicant's arguments filed August 29th, 2007 have been fully considered but they are not persuasive. With respect to claims 1, 3-5, and 7-9 rejected under 35 USC 112, 1st paragraph, Applicant's amendments to the claims has not removed the rejection. Claim 1's limitations remain in conflict with the teachings of the specification, as discussed above.

Applicant's arguments with respect to claims 1, 3-5, and 7-9 have been considered but are moot in view of the new ground(s) of rejection as discussed above.

Conclusion

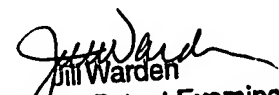
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Turk whose telephone number is 571-272-8914.

The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NT


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